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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,902	05/31/2001	Jonathan Robert Lamb		7755

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EXAMINER
EWOLDT, GERALD R

ART UNIT	PAPER NUMBER
	1644

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/870,902

Applicant(s)

LAMB ET AL.

Examiner

G. R. Ewoldt, Ph.D.

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply****A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 20 January 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 2,4-13,17,19,20,25,27,30 and 32 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) _____ is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) 2,4-13,17,19,20,25,27,30 and 32 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- 1) Certified copies of the priority documents have been received.
- 2) Certified copies of the priority documents have been received in Application No. _____.
- 3) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION

1. In the amendment filed 1/20/04 the claims have been amended such that a new restriction is required.

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 2, 4-9, 19-20, 25, and 27, drawn to method for producing a regulatory lymphocyte comprising contacting a lymphocyte with a primed APC, classified in Class 435, subclass 372.

II. Claims 10-11, 13, and 30, drawn to method for producing a regulatory lymphocyte comprising contacting a lymphocyte with a regulatory lymphocyte, classified in Class 435, subclass 372.3.

III. Claims 12, 17, and 32, drawn to a method for suppressing an immune response or treating a patient suffering from a disease characterized by inappropriate lymphocyte activity comprising administering a regulatory lymphocyte to a patient or mammal, classified in Class 424, subclass 93.71.

3. Inventions I-III are different methods. *In vivo* methods of treating patients (Group III) comprise significantly different process steps and endpoints than do *in vitro* methods (Groups I and II). Groups I and II differ in that they employ different regents (a lymphocyte, e.g., a T cell, versus an APC) to produce a regulatory lymphocyte. Therefore they are patentably distinct.

4. This application contains inventions drawn to patentably distinct species. Regardless of Group chosen, Applicant is further required under 35 U.S.C. § 121 to elect:

A) a **specific** substance for upregulating expression of Notch or a Notch ligand, such as those listed in Claims 46 or 7,

B) Notch or a **specific** Notch ligand, such as one of those listed in Claim 8.

C) and list all Claims readable thereon including those subsequently added. Currently all claims are generic.

5. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of

the other invention.

The different substances for upregulating expression of Notch or a Notch ligand comprise significantly different biological activities. For example, Noggin and IL-4 comprise unrelated molecules with unrelated functions on different cell types. Notch, versus ligands which bind Notch, also comprise unrelated molecules. The various Notch ligands comprise different activating capabilities under different conditions. Therefore, the species are independent and patentable over one another.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (571) 272-0843. The examiner can normally be reached Monday through Thursday from 7:30 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841.

Please Note: Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Technology Center 1600

RE
4/6/84
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PRIMARY EXAMINER